



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,693	10/25/2000	William Fitzpatrick	4797-30	3242

7590

04/20/2004

LESLIE GLADSTONE RESTAINO, ESQ  
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP  
163 Madison Avenue  
P.O. Box 1989  
MORRISTOWN, NY 07962-1989

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/696,693

Applicant(s)

FITZPATRICK ET AL.

Examiner

Siegfried E. Chencinski

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claim 12 is rejected** under 35 U.S.C. 102(b) as being anticipated by Clark et al. (US Patent 5,710,889).

**Re. Claim 12**, Clark anticipates a workstation for use in providing financial assistance, the workstation comprising:

- a central processing unit (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- a video display screen (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- an application interface operable on the workstation for accessing at least one finance-related software application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
- an investor monitoring system, wherein the workstation is connected to at least one host server over a communication system which enables communication between the workstation and at least one host server, and wherein the investor monitoring system monitors at least one investor account and transmits to the user a communication regarding at least one investor-mediated transactions on a real-time basis (Col. 5, line 63 – Col. 6, line 16; Col. 10, l. 49; Col. 11, ll.16-23; Col. 13, lines 63-64).

2. **Claim 14 is rejected** under 35 U.S.C. 102(b) as being anticipated by Clark et al.

**Re. Claim 14**, Clark anticipates an authentication system for creating an application interface of a financial assistance system, the authentication system comprising:

- means for allowing access to a plurality of finance-related software applications permitted by a user entitlement level, the plurality of finance-related software

Art Unit: 3628

applications comprising, a real-time market data application and a financial planning application (Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47);

- means for providing user preferences (Col. 2, ll. 36-58);
- a system for controlling the access to applications and the user preferences (Col. 25, line 64 – Col. 26, line 24); and
- a real time investor monitoring system for monitoring investor mediated transactions (Real time - Col. 10, line 49; Col. 11, ll. 16-23).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 1 & 3-11 are rejected under 35 U.S.C. 103(a) as being disclosed by Clark et al. in view of Maggioncalda et al. (US Patent 5,918,217).**

**Re. Claim 1,** Clark anticipates an integrated system for providing financial services, comprising:

- at least one workstation having a central processing unit and a video display screen (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);
- at least one host server (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);;
- the at least one host server connected to the at least one workstation over a communication system for transmitting information between a workstation and at least one host server (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);

Art Unit: 3628

- an application interface operable on the workstation for accessing at least on a plurality of finance-related software applications comprising a real-time market data application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
- a real-time investor monitoring system for monitoring investor mediated transactions (Real time - Col. 10, line 49; Col. 11, ll. 16-23), the system enabling a user therewith to provide timely proactive financial advice to investors (Clark's system is presented for the purpose providing financial services to customers, including financial advice).

Clark et al. do not explicitly disclose the providing of all inclusive financial advice, such as financial planning advice. However, Maggioncalda et al. do disclose the providing of a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future.

**Re. Claim 3**, Clark anticipates an integrated system as recited by claim 1, wherein the investor monitoring system monitors at least one investor account and transmits to the user a communication regarding at least one investor-mediated transaction on a real-time basis, thereby enabling the user to proactively intercede in the investor mediated transaction (Col. 5, line 63 – Col. 6, line 16; Col. 13, lines 63-64).

**Re. Claim 4**, Clark anticipates an integrated system as recited by claim 1, wherein the real-time market data application provides real-time market data comprising at least one of: quotes, news, and historical and intraday charting (Col. 3, ll. 23-25; Col. 7, l. 28-31; Col. 10, line 49; Col. 11, line 18, a server is inherent).

**Re. Claim 5**, Clark anticipates an integrated system as recited in claim 1, wherein the real-time market data application provides a valuation ratings for at least one financial instrument (Col. 24, ll. 43-49).

Art Unit: 3628

**Re. Claim 6,** Clark anticipates an integrated system as recited by claim 1, wherein the application interface further includes a scratchpad application for moving information between applications (Inherent in MS Windows).

**Re. Claim 7,** Clark does not explicitly disclose an integrated system as recited by claim 1, wherein the communication system connects a workstation to at least one host server via the Internet. However, Maggioncalda discloses an integrated system as recited by claim 1, wherein the communication system connects a workstation to at least one host server via the Internet (Col. 6, line 65).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of providing an integrated financial services system which can perform a number of different finance-related functions wherein the system connects a workstation to a host server via the internet.

**Re. Claim 8,** Clark does not explicitly disclose an integrated system as recited by claim 1, further comprising a financial advisor. However, Maggioncalda discloses an integrated system as recited by claim 1, further comprising a financial advisor (Page 2, Other Publications, Title – Net Results™, “Your On-Line Financial Advisor”).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of providing financial services which include an on-line financial advisor.

**Re. Claim 9,** Clark anticipates an integrated system as recited by claim 1, further comprising an authentication system for determining user entitlements and accessing a user preference profile (Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47).

**Re. Claim 10,** Clark anticipates an integrated system as recited by claim 9, wherein the authentication system populates the application interface based on the user entitlements (Col. 5, lines 13-28; Col. 25, line 64 – Col. 26, line 6).

**Re. Claim 11,** Clark anticipates an integrated system as recited by claim 9, wherein the authentication system provides access to all applications using a single logon process (Col. 25, line 64 – Col. 26, line 24).

**4. Claim 2 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Clark, in view of Maggioncalda et al. (US Patent 5,918,217) and Petruzzi (US Patent 5,806,049) and Fox (US Patent 5,132,899).

**Re. Claim 2**, Clark discloses an integrated system as recited by claim 1, wherein the plurality of finance-related software applications further comprise at least one finance related software application selected from the group consisting of (Col. 3, lines 17-23):

- a real-time market data application (Col. 10, line 49; Col. 11, line 18);
- a client information application (Clark, Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- an office productivity application (Fig. 15).

However, Clark does not explicitly disclose:

- a financial planning application;
- a calculator application;
- an investment products application;
- an opportunities application opportunities application; and
- an investment research application.

Maggioncalda discloses:

- a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33);
- a calculator application (Col. 1, lines 31-48; Col. 8, lines 24);
- an investment products application (abstract; Col. 2, lines 12-30, 54-65).

Also, Petruzzi discloses an opportunities application (Title); and

Fox discloses an investment research application (Fox Col. 5, lines 45-53; many available, among best known available on line is Value Line).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda, Petruzzi and Fox for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions,

Art Unit: 3628

and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future.

**5. Claim 13 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Clark, in view of Maggioncalda et al. (US Patent 5,918,217) and Petruzzi (US Patent 5,806,049) and Fox (US Patent 5,132,899).

**Re. Claim 13**, Clark discloses a workstation as recited by claim 12, wherein the financial-related software application comprises at least one finance-related software application selected from the group consisting of (Col. 3, lines 17-23):

- a real-time market data application (Col. 10, line 49; Col. 11, line 18);
- a client information application (Clark, Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
- an office productivity application (Fig. 15).

However, Clark does not explicitly disclose

- a financial planning application;
- a calculator application;
- an investment products application;
- an opportunities application; and
- an investment research application.

Maggioncalda discloses a workstation as recited by claim 12, wherein the finance-related software applications are selected from the group comprising:

- a financial planning application (Col. 2, line 33 – Col.3, line 63, Col. 5, lines 32-33);
- a calculator application (Col. 1, lines 31-48; Col. 8, line 24); and
- an investment products application (Abstract; Col. 2, lines 12-30, 54-65).

Petruzzi discloses an opportunities application (Title); and

Fox discloses an investment research application (Col. 5, lines 45-53).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of a financial advisory



Art Unit: 3628

system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future.

**6. Claims 15 and 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Clark, in view of Maggioncalda et al.

**Re. Claim 15**, Clark discloses a system for providing financial information to end users in a workstation and a host computer comprising:

- an application interface having:
  - means for selectively running finance-related software applications simultaneously (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
  - means for controlling the display of the finance-related software applications, the plurality of finance-related software applications comprising a real-time market data application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and

an authentication system having:

- means for determining a set of finance-related software applications that a user is entitled to selectively run and display (Fig. 15; Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47); and
- means for setting user preferences for the user based on a stored user preference profile (Col. 25, line 64 – Col. 26, line 24).

Clark et al. do not explicitly disclose the providing of all inclusive financial advice, such as financial planning advice. However, Maggioncalda et al. do disclose the providing of a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and,

Art Unit: 3628

perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future.

**Re. Claim 16**, Clark discloses a system as recited by claim 15, further comprising means for executing a controller that maps server names; retrieves entitlement levels; retrieves entitlement data; retrieves user preference profile; creates a local user directory; activates application interface with retrieved entitlement data and user preferences; and launches application interface (Col. 25, line 64 – Col. 26, line 24).

### ***Response to Arguments***

7. Applicant's arguments filed January 28, 2004 have been fully considered but they are not persuasive.

Applicant has amended claims 1-5, and claims 12-15. Of these amended claims each independent claim is amended, i.e. claims 1, 12, 13, 14 and 15. These amendments moved features around among the claims, but did not add any concepts not previously contained in the claims. The Examiner wishes to point out that only claimed limitations are at issue, which excludes features disclosed solely in the Specifications from consideration. An example of an argument based solely on the Specifications is the section contained on page 11, ll. 10-14.

A. Applicant argues that Clark et al. do not disclose, among other things, a real-time market data application and an investor monitoring system (page 9, ll. 12 through page 11, l. 30). As cited above in the rejection of claim 1, Clark discloses both features in Col. 2, l. 36 – Col. 3, l. 34.

B. Applicant argues from page 9, l. 14 through page 11, l. 30 that neither Maggioncalda et al., Petruzzi nor Fox disclose a real-time data application, nor do they provide any investor mediated transactions. It is sufficient that Clark discloses these features.

C. Applicant argues on page 11, l. 30 – page 12, l. 6 that "none of the references cited by the Examiner disclose or otherwise suggest means for selectively running and displaying the plurality of finance-related software applications simultaneously". Claim

X

Art Unit: 3628

15 contains such a limitation. Clark discloses simultaneous viewing in Col. 2, ll. 36-39, 65-66; Col. 3, ll. 7-10; Col. 28, ll. 33-35.

D. Applicant argues on page 12, ll. 7-21 that there is no suggestion or motivation to combine the references cited by the Examiner and that the references teach away from the present invention based on "trends favoring automating financial services" (l. 18).

**a) Regarding the argument that the prior art teach away from each other,** the Examiner is fully aware of the guidelines concerning this argument. The MPEP gives guidelines for teaching away in **MPEP § 2141.02** (prior art must be considered in its entirety, including disclosures that teach away from the claims) and **MPEP § 2143.01** (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

**Case law offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant.**

A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant's purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

It becomes clear that, contrary to Applicant's assertion, trends not cited in the references in a manner relevant to the specific use of the disclosures are moot. There are no such disclosures in the four references. Importantly, each reference is from the

Art Unit: 3628

same field of prior art, namely that of providing financial services to individuals and businesses.

**b) Regarding Applicant's argument that there is a lack of motivation to combine these references.**

(1) The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. **In re Nomiya**, 509 F.2d 566, 184 USPQ 607, (CCPA 1975).

(2) As discussed in **MPEP § 2143.01**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references, as discussed in the aforementioned section.

(3) There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. **In re McLaughlin** 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

(4) References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. **In re Bozek**, 163 USPQ 545 9ccpa) 1969.

(5) In this case, it would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda, Petruzzi and Fox for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future.

**Conclusion**

Art Unit: 3628

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703-308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks Washington D.C. 20231*

or faxed to:

(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-9601 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2411 Crystal Drive, Arlington, VA, 7th floor receptionist.

Application/Control Number: 09/696,693

Page 13

Art Unit: 3628

SEC

April 19, 2004



HYUNG SOUH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600